REMARKS

This paper is responsive to the Office Action mailed on March 20, 2006 in connection with the above-identified patent application. Applicants respectfully request that the claims pending in the application be reconsidered in view of the following remarks. Further, allowance of all pending claims is respectfully requested.

The current status of the claims

Claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Word 2000, (c) 1983-1999 by Microsoft Corp. (hereinafter "MS Word") in view of William B. Hayes, Using PowerBuilder 6 (QUE Corp. 1997) (hereinafter "PowerBuilder"). Office Action at page 2.

Applicants respond to the rejections

Applicants' remarks in the Amendment B and in the Response mailed December 30, 2005 are believed to remain pertinent, and are incorporated herein by reference. The following additional remarks address the MS Word dialog windows cited in the present Office Action, and the next section herein addresses the Response to Arguments section of the present Office Action.

As a threshold point, the MS Word dialog windows applied in the present Office Action are cumulative to the background prior art and to the references of record. The present Office Action states:

> Figure 5 is the Find and Replace box available from the Edit menu, where the user has not yet entered any search items. Figure 5 discloses a text entry space in a dialog box displayed on a screen of the display device for free form entry of text by the user.
>
> ...
>
> MS Word fails to disclose the selective display of a selection button (i.e., the show-list-button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory. In the examples described above the show-list-button is always

<u>displayed</u>.

Office Action at page 3 (underscores added).

Thus, the newly cited dialog window of FIGURES 5-7 merely shows what the Background of the present application previously described as prior art – a free-form text entry dialog box with drop-down list of prior text entries, in which the drop-down list button is always displayed. Such dialog boxes are confusing particularly to novice users who are likely to believe it is a pure drop-down selection box. Those users are further confused when operation of the drop-down list button fails to provide a list of selectable entries. Confused <u>users may also fail to recognize the free-form text entry option</u> (which is the only viable option upon initially opening the dialog window) and may therefore fail to successfully interact with the dialog box, or may be substantially delayed in successful interaction due to the aforementioned confusion.

PowerBuilder does not help alleviate the confusion because it only provides for certain selectively displayable selection buttons. The present Office Action notes:

> PowerBuilder 6 discloses dialog box controls that have intelligence built into them wherein the controls are conditionally displayed based upon the volume of items in memory. PowerBuilder 6 discloses controls built into the drop down box selection button (the arrow) on page 3. PowerBuilder recites: "*Always Show Arrow: The Always Show Arrow checkbox always shows the arrow that opens the list box. If Always Show Arrow is unchecked, the arrow is shown only when the column has focus.*" PowerBuilder 6 discloses conditional program execution related to visibility of the arrow.

> PowerBuilder 6 further discloses the conditional program execution of the visibility of controls in relation to the volume of data in the memory of the <u>list box</u> on page 2. PowerBuilder 6 recites: "*Disable Scroll: If Disabled Scroll is checked, the scroll bar will always be visible but will be disabled when you can access all the items without scrolling. If this property is not checked, the scroll bar will be displayed only if necessary, based on the number of items and the height of the listbox.*" So, if the listbox is set

> to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. Furthermore, in this example, if the memory holds one or more text items, the scroll bar would be visible. <u>PowerBuilder 6 discloses selectively displaying a text entry box control</u>, wherein the selective displaying is based upon the items stored in memory.

Office Action at pages 4 (underscores added).

The Examiner states that PowerBuilder discloses selectively displaying a text entry box control, based upon the number of items In memory. If the listbox is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. Furthermore, in this example, if the memory holds one or more text items, the scroll bar would be visible. Applicants argued earlier and argue now that while PowerBuilder displays a form of a control button, the scroll bar control button does not indicate to the user the <u>input functionality associated with the text entry box</u>. In other words, the presence of a <u>scroll bar does not indicate to users that text can be entered into another associated text box</u>. The <u>scroll bar provides no invitation</u> to the user to <u>enter text</u> into any <u>text box</u>. This is in stark contrast with embodiments of the present invention which provide a free-form text entry dialog box, which to a user appears as a conventional text box (as discussed with reference to the prior art). In addition, when appropriate, <u>the free-form text entry dialog box includes a drop-down arrow</u> indicating to a user whether previous entries are available, without confusing the user into thinking that new or original entries can be made into that text entry box.

With respect to the MS Word reference, the first example relates to showing a selection arrow upon focus. Such a selective displaying, even if incorporated into the cited MS Word dialog box, <u>would not solve the problem of user confusion</u>. It would merely delay the user's confusion until he or she focuses the mouse pointer onto the dialog box. The second example relates to a listbox which does not provide free-form text entry — hence, the Office Action's characterization of this example as disclosing

"selectively displaying a <u>text entry</u> box control" is inaccurate.

None of the previously or newly cited portions of MS Word, PowerBuilder, or their combination, disclose or fairly suggest the features of claim 2 (at least the feature "means for selectively displaying a selection button on the screen of the display device <u>in association</u> with the dialog box for selection by the pointing means, the selection button being displayed solely when the memory contains at least one previously entered text item" is not disclosed), claim 8 (at least the feature "displaying a drop-down list selection button on the screen of the display device only if the counting produces a value greater than zero" is not disclosed), and claim 21 (at least the feature "a drop-down list selection button displayed <u>in conjunction</u> with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry" is not disclosed). It should be noted the above referenced claims – 2, 8 and 21 – describe <u>the coupling of input features and the list viewing features</u>. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

Applicants respond to the Response to Arguments section

Applicants' previous Response noted that in the Office Action mailed September 30, 2005 the motivation for the proposed combination of MS Word and PowerBuilder is taken from the present application. In response, the Examiner in the present Office Action states:

> But so long as it [judgment of obviousness] takes into account only knowledge which was with the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Office Action at page 7.

As stated previously, it is submitted again that the Office Actions to date <u>do not propose</u> a <u>motivation</u> for <u>making the combination</u>. Applicants reemphasize that the

initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §2142.

The present Office Action identifies no express or implied teaching in the references to make the proposed combination. Moreover, the Office Action does not provide a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious. It merely allegedly identifies pieces of the present claims in two different references (as noted previously, Applicants do not agree that the references show all said pieces), and states that it would have been obvious to make the combination "in order to provide a visible indication that the control is usable." (Office Action at page 5).

Nothing in the references, alone or in combination, suggests a motivation to combine text entry features with text viewing features in one free-form text entry dialog box. The references do not recognize that there is a problem with the combination box that is explicitly taught in cited MS Word FIGURES 5-7. MS Word certainly does not recognize the problem of confusion – it employs precisely the type of combination box that can confuse novice users. PowerBuilder does not recognize the problem – although it provides selectively displayed selectors for viewing lists, neither of the two selectively displayed selectors cited in the Office Action are directed toward alleviating the source of confusion addressed by the present application. The references cannot motivate making a combination to solve a problem that is not recognized in any of the references.

Because the Office Action does not provide a motivation for making the combination, a prima facie case of obviousness has not been made. Accordingly, Applicants have no duty to present rebuttal evidence supporting patentability.

Nonetheless, <u>Applicants note</u> that such rebuttal evidence exists. Applicants reemphasize that the <u>references</u> themselves <u>teach away from</u> the <u>proposed combination</u>. It is improper to combine references where the references teach away from their combination. MPEP § 2145, citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prima facie case of obvious may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. MPEP § 2144.05, citing In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Here, the MS Word reference clearly teaches away from the claims of the present application. MS Word discloses <u>precisely</u> the type of prior art combination box which the <u>present application</u> recognizes as confusing. But, MS Word does not recognize it as confusing – rather, MS Word employs that very combination box in a widely sold commercial word processing package. The skilled artisan considering MS Word would likely conclude that this combination box is entirely adequate, and would not be motivated to consider attempting to improve the dialog box.

Moreover, the level of skill in the art should be considered. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP § 2141.03. In considering the present application, the skilled artisan is likely to be someone with at least some familiarity with computers and GUI interfaces.

As argued by Applicants in the previous Response of December 30, 2005, the relatively high level of computer skills of the ordinary artisan further rebuts a finding of obviousness of the present application. It should be noted that this argument was not countered in the present Office Action. An insight of the present application is that a novice user, who is far removed from the level of the ordinary skilled artisan in the computer software arts, might find the dialog box of MS Word FIGURES 5-7 confusing. The skilled artisan's familiarity with computers and GUI interfaces makes it difficult for the skilled artisan to recognize the potential for confusion on the part of the novice user. Additionally, the advantages provided by the present application are

directed to enhancing the usability of GUI interfaces by providing an improved text entry box that conveys to novice users that text entry can be performed; and, in the event that previous text entries are available, a drop down arrow is included to enable selection of the previous entries.

Applicants respectfully request reconsideration and allowance of the application

The cited references, either alone or in combination, fail to disclose or fairly suggest all the elements of the claims of the present application. For example, the cited references alone or in combination do not disclose or fairly suggest the element of claim 21 that a drop-down list selection button be displayed in conjunction with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry. Stated another way, the cited references do not disclose or fairly suggest a drop-down list selection feature coupled with a free-form text entry feature.

Moreover, applicants reassert that the proposed combination of MS Word and PowerBuilder appears to improperly employ the rejected claims as a blueprint for abstracting alleged individual teachings from the references. See Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 U.S.P.Q. 657 (Fed. Cir. 1985). Having abstracted the individual teachings, the Office Action then cites a motivation set forth only in the present application, and not in the references. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. MPEP § 2143, citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of the foregoing remarks, applicants respectfully request that the application be reconsidered and pending claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 be allowed.

CONCLUSION

In view of the above remarks, it is respectfully submitted that all pending claims are patentably distinct and unobvious over the references of record.

Allowance of all pending claims and early notice to that effect is respectfully requested.

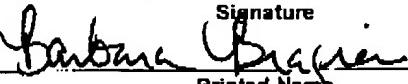Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

Michael E. Hudzinski, Reg. No. 34,185
1100 Superior Avenue
Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

_2φ5υN/φ6_
Date

CERTIFICATE OF MAILING

Under 37 C.F.R. § 1.8. I certify that this Response is being

☐   deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

☒   transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.

☐   deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP ___, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:	Signature
Date	Printed Name
June 20, 2006	Barbara Brazier

N:\BMZ\200004\bjh0004721\V001.doc

Page 13 of 13